



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/730,937

12/10/2003

David Bain

B5BAI004.14

6316

7590

03/07/2006

Merek, Blackmon & Voorhees, LLC
673 S. Washington St.
Alexandria, VA 22314

EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/730,937	Applicant(s) BAIN, DAVID	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-15 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 9/19/05 has been entered. Claims 3-15 are pending.

Claim Objections

1. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 requires the carry out of the steps on an on-line website but claim 4 says the broadcasting is carried out on television which is improper because television does not further limit on-line site.
2. Claims 10-12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 9 requires the broadcasting of a bounty offering (or 1 offering) but claim 10 calls for broadcasting a plurality of bounty offerings simultaneously which does not further limit a bounty offering of claim 1 above.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 3-8, and 9-15 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The step of "donation of the reward by the beneficiary to the charity organization or research funds is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Furthermore, the preamble calls for a method of raising capital but fails to show how the capital is raised and for whom? It appears that the raising of the capital is for a non-profit entity and wherein the reward is donated to the non-profit entity.

5. Claims 3-8 and 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) In independent claims 3 and 9, the preamble calls for "a method of raising capital" but there is no discussion in the body of claims 3-8, 9-15 how the capital is raised and for whom?

(2) In the 1st step of claims 3 and 9, there is a citation of "for registering" but it's not clear who are the registrar or registering whom? Contestant or beneficiary?

(3) In claim 3, the last step is vague because it's not clear where the reward goes to? Also, in claim 3, the 2nd and the last step appear to be conflicted with each other

Art Unit: 3629

since the 2nd step says that when an actor (contestant) completes the condition, the actor (contestant) becomes the beneficiary but the last step says that the actor (contestant) is not the beneficiary?

(4) In claim 8, the phrase "wherein said bounty is broadcast to a plurality of viewers" is vague since it's grammatically incorrect.

(5) Claims 11, 12, 13, line 2, the phrase "an competition reward" is grammatically incorrect and lines 3-5 are wordy and confusing.

6. Dep. claim 13 recites the limitation "said plurality of bounty offerings" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 9-10, 14, 15, 3 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KAPLAN (US 2002/0076674).

As for independent method¹ claim 9, on Fig. 4B, KAPLAN discloses a method of fundraising for charity comprising the steps of:

(a) establishing an on-line site for registering and broadcasting a bounty offering (game or competition with reward) {see [0003, 0051 "*Online Distributed Problem Solving*" (ODPS), 0058, 0059, 0060, Fig. 4A, Fig. 4B];

(b) said bounty offering including a reward offered by at least one benefactor (giver) {[0058 "*how much money the customer is willing to pay*"] and a condition to be completed (solving the problem) in order for a beneficiary to receive the reward {[0060, 0061]};

(c.) broadcasting said bounty offering on-line to a plurality of participants (parties) {[0051, 0065], Figs. 1, 4B];

Art Unit: 3629

(d) selecting the beneficiary from the plurality of participants (parties) by determining a first party to complete the condition (solving the problem) {Figs. 1, 4A and 4B, [0060, 0061]}.

Alternatively, the selection of the giver (or benefactor) for the bounty offering depends on each circumstance or event (business or illness or charity) and would have been obvious to a skilled artisan as mere selection of specific event.

As for dep. claim 10 (part of 9 above), which deals with broadcasting parameters, i.e. broadcasting a plurality of events simultaneously, this feature is taught in [0026, 0042 “*simultaneously*”, 0220 “*simultaneously*”]. Alternatively, the presentation of more than one bounty offering vs. an offering would have been obvious to a skilled artisan as mere duplicate of parts for multiple effects. See *In re* Harza, 124USPQ378, CCPA 1960.

As for dep. claim 14 (part of 9 above), which deals with the type of condition or conditioning parameters, i.e. the solving of a problem, this is non-essential to the scope of the claimed invention and is taught in Figs. 1, 4A or 4B or [0024-0025].

As for dep. claim 15 (part of 9 above), which deals with the type of condition or conditioning parameters, i.e. the solving of a problem such as a cure for a disease, this is non-essential to the scope of the claimed invention and is taught in Figs. 1, 4A or 4B or [0024, 0025].

As for independent method² claim 3, which has the same limitation as in independent method claim 9 above, except for the last phrase, “wherein the actor (participant) is not the beneficiary, it’s rejected for the same reason set forth in claim 9

Art Unit: 3629

above and with especial attention to Fig. 4B, top paragraph, wherein the total reward of \$500.00 has been given to charity "*total charitable donation amount of \$500.00 has been split among several questions*".

11. Dependent claims 11-13, 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over KAPLAN.

As for dep. claims 11-13 (part of 9 above), which deal with donation or benefactor parameters, i.e. 2nd benefactor paying a competition reward, etc., these are non-essential to the scope of the claimed invention and would have been obvious to do so as mere different ways of providing a reward money while involving more people, thus reducing the amount of giving/person.

As for dep. claim 5 (part of 9 above), which deals with broadcasting parameters, i.e. broadcasting a plurality of events simultaneously, this feature is taught in [0026, 0042 "*simultaneously*"], 0220 "*simultaneously*"]. Alternatively, the presentation of more than one bounty offering vs. an offering would have been obvious to a skilled artisan as mere duplicate of parts for multiple effects. See *In re Harza*, 124USPQ378, CCPA 1960.

As for dep. claims 6-7 (part of 9 above), which deal with donation or benefactor parameters, i.e. incentive for giving and managing the donation amount, etc., these are non-essential to the scope of the claimed invention and would have been obvious to do so to provide incentive for giving and effectively managing the donation amount.

As for dep. claim 8 (part of 9 above), which deal with donation or benefactor parameters, i.e. many viewers contribute money toward the reward, this are non-

Art Unit: 3629

essential to the scope of the claimed invention and would have been obvious to do so to involve more people as fairly taught in Figs. 4A or 4B "World Think", "Global Community of Online Experts", thus reducing the amount of giving/person.

12. Claims 3-8 are rejected (2nd time) under 35 U.S.C. 103(a) as being unpatentable over KAPLAN in view of SMITH (US 2002/0111815).

As for independent method² claim 3, the teachings of KAPLAN is cited above. SMITH is cited to teach that if a donor's financial situation suddenly improves such as winning a game award, the donor may be inclined to be more generous such as giving to charity {see [0005]}. It would have been obvious to modify the teachings of KAPLAN by allowing the winner of a game or competition to give the award to charity as taught by SMITH above as mere being generous.

As for dep. claims 4-8 (part of 9 above), they are rejected for the same reasons set forth above.

Response to Arguments

13. Applicant's arguments with respect to claims 1-2 have been considered but are moot in view of the new ground(s) of rejection which are caused by applicant's amendments.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

No claims are allowed.

Art Unit: 3629

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. My email is dean.Nguyen@uspto.gov.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
March 2, 2006


DEANT. NGUYEN
PRIMARY EXAMINER